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OFFICE OF PETITIONS

In re Application of Sexton :
Application No. 09/966,807 :
Filing Date: August 10, 2006 :
Attorney Docket No. N22335 :

Decision on Petition

This is a decision on the petition filed June 28, 2006, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition is **dismissed**.

Facts:

A non-final Office action was mailed on December 15, 2004.

Attorney Mark Patterson filed a response and amendment on May 19, 2005. Patterson is not an attorney of record for the application.

37 CFR 1.121(c) states: "No claim text shall be presented for any claim in the claim listing with the status of 'canceled' or 'not entered.'"

The May 19, 2005 amendment included two canceled two claims. The canceled claims included claim text.

A Notice of Non-Compliant Amendment was mailed August 11, 2005.

A Notice of Abandonment was mailed March 21, 2006.

The law firm of record forwarded the Notice to Patterson. The petition states Patterson did not receive the response until after the deadline for response had passed.

Discussion:

35 U.S.C. 133 requires that if an action is mailed, and if an applicant fails to respond to such action within 6 months or within any shorter time period set by the Office, the application goes abandoned as a matter of law. A Notice was properly mailed to the address of record on August 11, 2005. Petitioner failed to respond to the Notice within the time period set in the Notice. Therefore, the application is abandoned as a matter of law.

Petitioner cites *Acceptance of Certain Non-Compliant Amendments Under 37 C.F.R. § 1.121(c)*, Official Gazette Notices (July 5, 2005). The Notice indicates the USPTO will not enforce the requirement canceled claims not include claim text. However, the fact the Notice was "incorrect" does not alter the fact a Notice was mailed and a reply was not timely received.

35 U.S.C. 133 does not distinguish "correct" Office actions from "incorrect" Office actions. Abandonment is not based on the correctness, in whole or in part, of an Office action. For example, if an applicant fails to respond to a restriction requirement later determined to be untenable as drafted, the application is abandoned. If an Office action is mailed rejecting claims based on anticipation over a reference that was facially not available as prior art against the application, an applicant must still respond to the Office action in order to avoid abandonment.

Petitioner failed to respond to the Notice of Non-Compliant Amendment. Such response could have taken the form of a written traversal stating the facts in the instant petition regarding the prior amendment. Petitioner could have directly contacted the examiner and taken steps to have the examiner withdraw the Notice in writing prior to the expiration of the time period for response.

For the reasons above, the holding of abandonment will not be withdrawn.

Petitioner may wish to file a petition to revive pursuant to 37 CFR 1.137.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted.

The power of attorney and change of correspondence address filed with the petition is accepted.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions